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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,826	09/24/1999	ANNETTE WAGNER	082225.P2813	9950
7590	08/10/2004		EXAMINER	DAVIS, TEMICA M
JORDAN M BECKER BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 900251026			ART UNIT	PAPER NUMBER
			2681	20
DATE MAILED: 08/10/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/405,826	WAGNER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Temica M. Davis	2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 May 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 35-49 and 53-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 35-49, 53-56 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed May 3, 2004 have been fully considered but they are not persuasive.

Applicant argues that Smith fails to disclose a user initiating a transmission mode and in response to initiating the transmission mode, automatically selecting a form of a message to be transmitted, wherein the form is selected based on the content of the displayed information at the time the transmission mode is initiated.

The examiner, however, respectfully disagrees. Smith discloses a mobile telephone (MT) capable of receiving and sending voice, fax, e-mail, ink and SMS messages (col. 3, line 40-col. 4, line 36). In the event the user of the MT receives one of the above type messages (for example an ink/SMS message) and desires to respond to the message, the user selects the TOOL button and selects the write option (col. 11, lines 1-10; figure 13B). The selection of the write option initiates a transmission mode (SEND option) and the automatic selection of the form for a message to be transmitted based on the content of the displayed information at the time the user input is received is met as evidenced by the fact that the MT knows what type of message is being displayed (i.e., fax, ink, e-mail, etc.) See for instance figure 7A, which shows the different types of messages the MT has received. As such, when the user initiates a reply mode, the MT will know the type of form the reply should be in (col. 7, line 50-col. 8, line 17, col. 8, line 46-col. 9, line 22 and col. 10, line 3-col. 11, line 31).

Applicant further argues that Mäkelä in combination with Smith fails to disclose automatically selecting a message to be transmitted in response to detecting predetermined content.

Regarding this limitation, the examiner did admit that Smith fails to disclose wherein the step of automatically entering a mode for allowing a user to transmit a message from the telephone did not include the further step of automatically selecting a message to be transmitted in response to detecting the predetermined content

In Smith, the message is one in which the user has to manually enter the desired message to be sent while in reply mode (col. 10, line 61-col. 11, line 10; figures 13A-13C). As explained above, the automatic selection of the form for the message to be transmitted based on predetermined content is already met in Smith. Mäkelä was only brought in to show that a user does not have to manually respond to a call, but rather a pre-stored message can be automatically sent back to a caller (col. 5, line 53-col. 6, line 16). Such an automatic response would save a user the time from having to manually input a reply message.

Based on the above remarks, the rejections stand as set forth below.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 35-38 and 40-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (Smith), U.S. Patent No. 6,333,973.

Regarding claims 35 and 44, Smith discloses a method/means of allowing a user to transmit a message in a portable telephone, the portable telephone including a display device, the method comprising the steps of: receiving previously requested data from a remote source (i.e., from the SMS, e-mail, fax or voice server) (col. 8, lines 27-35, col. 10, lines 17-56; figure 5); displaying information representative of the previously requested data on the display device (col. 8, lines 30-40; figure 7A, 7B, 13A-13D); in response to a user input initiating a transmission mode, automatically selecting a form for a message to be transmitted based on a content of the displayed information at the time the user input is received as evidenced by the fact that the terminal can determine the ID of the caller and the detect which type of call/message is received (col. 8, lines 52-65, col. 10, line 61-col. 11, line 31).

Regarding claims 36 and 45, Smith discloses a method according to claims 35 and 44, wherein the portable telephone is configured to send and receive electronic mail messages; and wherein the step of automatically selecting a form for a message to be transmitted comprises the step of automatically selecting a form for an outgoing electronic mail message based on a content of the displayed information at the time the user input is received (col. 10, line 38-col. 11, line 31).

Regarding claim 37, Smith discloses a method of enabling a portable telephone to allow a user to transmit a message, the method comprising the step of transmitting sequences of instructions from a host processing system to the portable telephone, the sequences of instructions including instructions which, when executed on the portable telephone, cause the portable telephone to perform the method recited in claim 35 (via processor 3300, col. 5, lines 14-18 and lines 50-57).

Regarding claim 38, Smith discloses a machine-implemented method of allowing a user to transmit a message in a portable telephone, the method comprising the steps of: receiving data from a remote source; monitoring the content of the data for predetermined content; and in response to detecting the predetermined content (i.e., caller information, fax, e-mail, sms, etc), automatically entering a mode for allowing a user to transmit a message from the telephone (col. 8, lines 26-45, col. 10, line 61-col. 11, line 19; figures 7A, 7B, 13A-13D).

Regarding claim 40, Smith discloses a machine-implemented method according to claim 38, wherein the step of automatically entering a mode for allowing a user to transmit a message from the telephone comprises the step of automatically selecting a format of a message to be transmitted in response to detecting the predetermined content (col. 8, lines 26-45, col. 10, line 61-col. 11, line 31; figures 7A, 7B, 13A-13D).

Regarding claim 41, Smith discloses a machine-implemented method according to claim 40, wherein the telephone is configured to send and receive electronic mail messages and to display received electronic mail messages to a user; and wherein the

step of automatically selecting a format of a message to be transmitted comprises the step of automatically selecting a form for an outgoing electronic mail message in response to detecting the predetermined content (col. 8, lines 26-45, col. 10, line 61-col. 11, line 19).

Regarding claim 42, Smith discloses a method of enabling a portable telephone to allow a user to transmit a message, the method comprising the step of transmitting sequences of instructions from a host processing system to the portable telephone, the sequences of instructions including instructions which, when executed on the portable telephone, cause the portable telephone to perform the method recited in claim 38 (col. 5, lines 14-18 and lines 50-5; figure 37).

Regarding claims 43 and 46, Smith discloses a method according to claims 36 and 46, wherein the form is pre-configured to include a destination address (col. 10, lines 61-65; figures 13A-13D, 14A, 14B).

Regarding claim 47, Smith discloses a portable telephone (figures 2 and 3) comprising: an input device (2300); a display device (2400); a transceiver (3100) configured to receive a communication from a remote source over a wireless link; and a control circuit (3300) coupled to the display device and the receiver, the control circuit configured to cause information representative of the communication to be displayed on the display device, the control circuit further configured to detect a user input at the input device initiating a transmission mode, and further configured to respond to the user input by selecting a form for a message to be transmitted based on

a content of the displayed information at the time the user input is received (col. 10, line 17-col. 11, line 31).

Regarding claim 48, Smith discloses a portable telephone according to claim 47, wherein the transceiver is configured to send and receive electronic mail messages over the wireless link; and wherein the control circuitry is configured to automatically select a form for an outgoing electronic mail message based on a content of the displayed information at the time the user input is received (col. 5, lines 19-20, col. 10, line 38-col. 11, line 31).

Regarding claim 49, Smith discloses a portable telephone according to claim 48, wherein the form is pre-configured to include a destination address (col. 10, lines 61-65, col. 11, lines 20-31).

Regarding claim 53, Smith discloses a portable telephone comprising: means for carrying out a two-way telephone communication over a wireless link (col. 4, lines 15-35), means for receiving non-voice data from a remote source (col. 4, lines 15-35); means for monitoring the content of the data for predetermined content; and means, responsive to detecting the predetermined content, for automatically entering a transmission mode for allowing a user to transmit an electronic mail message from the telephone (col. 8, lines 26-45, col. 10, line 61-col. 11, line 9).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 39 and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Mäkelä et al (Mäkelä), U.S. Patent No. 6,301,338.

Regarding claims 39 and 54, Smith discloses a machine-implemented method according to claim 38 as described. Smith, however, fails to disclose wherein the step of automatically entering a mode for allowing a user to transmit a message from the telephone comprises the step of automatically selecting a message to be transmitted in response to detecting the predetermined content.

In a similar field of endeavor, Mäkelä discloses activation of a telephone's own call equipment according to the number of the calling party. Mäkelä further discloses automatically selecting an SMS message to be transmitted in response to detecting the predetermined content of an incoming call (col. 5, line 53-col. 6, line 16).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Smith with the teachings of Mäkelä for the purpose of saving the user time from having to manually input a reply message.

Regarding claim 55, the combination of Smith and Mäkelä discloses a portable telephone according to claim 54, wherein the means for automatically entering a mode for allowing a user to transmit an electronic mail message from the telephone comprises means for automatically selecting a format of a message to be transmitted in response to detecting the predetermined content (Smith, col. 8, lines 26-45, col. 10, line 61-col. 11, line 19).

Regarding claim 56, Smith discloses a portable telephone communication device comprising: a display device (2400), a transceiver (3100) configured to carry out a two-way telephone communication and further configured to receive non-voice data from a remote source (col. 4, lines 15-35); a control circuit (3300) coupled to the transceiver and the display device (figures 2 and 3), the control circuit configured to detect predetermined content in the non-voice data, to enter a transmission mode for allowing a user to transmit an electronic mail message in response to detecting the predetermined content (col. 10, line 38-col. 11, line 19).

Smith, however, fails to disclose automatically select a message to be transmitted in response to detecting the predetermined content.

Mäkelä reads on this limitation (col. 5, line 53-col. 6, line 16).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Smith with the teachings of Mäkelä for the purpose of saving the user time from having to manually input a reply message.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Davis  
Examiner  
Art Unit 2681

August 5, 2004



TEMICA M. DAVIS  
PATENT EXAMINER